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Paper No. 16

Appeal No. 93-1821

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BOARD OF PATENT APPEALS
AND INTERFERENCES

ON-BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte John W. Olney

Application for Patent filed April 26, 1991, Serial No. 07/691,974, which is a division of Serial No. 07/424,548 filed October 20, 1989, now Patent No. 5,034,400 issued July 23, 1991. Compounds for Preventing Neurotoxic Side Effects of NMDA Antagonists.

Patrick D. Kelly et al. for appellant.

Supervisory Patent Examiner - Frederick E. Waddell.
Examiner - Kevin Weddington.

Before Goldstein, Seidleck and Winters, Administrative Patent Judges.

Goldstein, Administrative Patent Judge.

This appeal is from the examiner's final rejection of claims 1 to 7. Claims 8 to 11 have been withdrawn from further

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consideration by the examiner under 37 C.F.R. 1.142(b). There are no allowed claims. Illustrative claim 1 is reproduced below.

1. A pharmaceutical agent comprising a mixture of an NMDA antagonist and an anti-cholinergic agent, both of which can penetrate blood-brain barriers, wherein the NMDA antagonist is present in a therapeutically effective quantity sufficient to reduce excitotoxic damage in the brain if administered to a mammal, and wherein the NMDA antagonist can cause neurotoxic side effects in the brain if administered without an accompanying anti-cholinergic agent, and wherein the anti-cholinergic agent is present in a second quantity that can reduce the neurotoxic side effects which would be caused by the NMDA antagonist if administered without the accompanying anti-cholinergic agent.

References relied on by the examiner on appeal are:

Olney et al. (Olney), "Anti-parkinsonian agents are phencyclidine agonists and N-methyl-aspartate antagonists," *European Journal of Pharmacology*, Vol. 142, 1987, 319-320.

Freedman et al. (Freedman), "Muscarinic M₁, M₂ receptor binding. Relationship with functional efficacy," *European Journal of Pharmacology*, Vol. 156, 1988, 133-142.

All of the claims on appeal are stated in the examiner's answer as having been finally rejected under 35 U.S.C. 102 and 103 as being either anticipated by or obvious from the combined teachings of Olney and Freedman. We shall not affirm this rejection.

We must conclude that the rejection under section 102 is an inadvertent error of some kind, perhaps typographical. In certain instances, a rejection for anticipation can be supported by a second reference to illustrate that the disclosure of the first reference is enabling or a starting material is available

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or something of that sort. There is no explanation of that type in the examiner's answer, so in this case, to whatever extent this rejection was made intentionally, we summarily reverse it.

A superficial reading of the appealed claims might have suggested that they would have been *prima facie* obvious from the disclosures of the references. It is clear from appellant's specification and the references that the materials characterized by appellant as NMDA antagonists and those characterized as anti-cholinergic agents do not form mutually exclusive classes. Additionally, the materials disclosed as anti-parkinsonian agents by Olney appear to form a class containing both types of materials recited in appellant's claims. Furthermore, all of the claims in the table of Olney are disclosed as being anti-excitotoxic agents. Thus the decision in *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069 (C.C.P.A. 1980), is relevant. However, in this case it is not controlling for the reasons which follow.


The examiner has failed to deal with the fact that appellant's claims are limited in functional language to NMDA antagonists which cause neurotoxic damage and to anti-cholinergic agents which reduce that damage. The examiner has provided no explanation for how one of ordinary skill in the relevant art would have been led to this particular type of combination.


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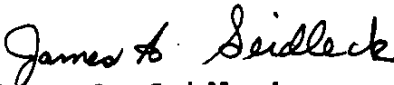
Furthermore, these functional limitations in the claim are supported by evidence in the working examples in appellant's specification. Thus, the totality of evidence on this record, taken together with the inadequate explanation by the examiner, leads to a legal conclusion of unobviousness for the claimed subject matter.

The decision of the examiner is reversed.

REVERSED


Melvin Goldstein
Administrative Patent Judge


Sherman D. Winters
Administrative Patent Judge


James A. Seidleck
Administrative Patent Judge

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